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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/448,606	11/24/99	BONICEL	056891

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EXAMINER

NGUYEN, C

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 10/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/448,606

Applicant(s)
Jean-Pierre Bonicel

Examiner
Chau Nguyen

Group Art Unit
2831



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-5 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-5 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it contains legal phraseology often used in patent claims, “comprising” in line 3. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 4-5, “at least one reinforcing wire or armoring wire” is unclear to how this at least one relates to the at least one reinforcing wire or armoring wire recited in lines 2-3.

Claim 2, lines 2-3, “at least one layer of armoring” is unclear to how this relates to one or more layers of wires recited in claim 1.

Claim 3, lines 2-3, “at least one reinforcing wire or armoring wire” is unclear to how this at least one relates to the at least one reinforcing wire or armoring wire recited in claim 1.

Claim 3, line 4, “NUOVINOW” should be changed to --NUOVINOX--.

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Claim 3, line 4; and Claim 5, line 4 contain the trademark/trade name NUOVINOX.

Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a composite steel wire or tube and, accordingly, the identification/description is indefinite.

Claim 4 recites "in which a tube is provided", however the position of the tube in the cable is unclear.

Claim 5, line 2, "a tube" is unclear to how this relates to the tube recited in claim 4.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marlier et al. (5,125,062) in view of Kazuya (JP 1-276507).

Marlier et al. discloses a telecommunication cable that is structurally reinforced by incorporating at least one reinforcing wire or armoring having one or more layers of wires, the cable including at least one reinforcing wire or armoring wire which has a core (4,5) of steel (claim 1). Marlier et al. also discloses a tube (1) being provided in the cable and the tube being made of steel (claim 4). Marlier et al. does not disclose the steel core or sheet being covered by a layer of stainless steel to form a composite steel core or sheet (claims 1, 2 and 4).

Kazuya discloses a composite steel wire in which a steel core is covered by a layer of stainless steel (4). It would have been obvious to one skilled in the art to cover the steel core and the steel sheet of Marlier et al. with a stainless steel layer to protect the wire from lightning strike as taught by Kazuya.

6. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marlier et al. in view of Kazuya as applied to claims 1 and 4 above, and further in view of Applicant's own disclosure (page 4, lines 7-16).

Re claims 3 and 5, it would have been obvious to one skilled in the art to use the composite steel material sold under the registered trademark NUOVINOX for the wire and the tube of the Marlier et al. cable since this material is commercially available and can be drawn into

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a wire or a tube. In the case of a wire form, the wire can be used as reinforcing wires or armoring wires as disclosed by the applicant (page 4, lines 7-16).

Cited Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rafie et al. discloses cables comprising armoring wires.

Communication

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N. Nguyen whose telephone number is (703) 308-0693.

A handwritten signature in black ink, appearing to read "Chau N. Nguyen". The signature is fluid and cursive, with the first name "Chau" and last name "Nguyen" clearly distinguishable.

Chau N. Nguyen

Patent Examiner

September 28, 2000